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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,388	11/20/2003	Truett P. Mills	TPM-43-CIP	9729

44728 7590 06/15/2005

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

<b>Office Action Summary</b>	<b>Application No.</b> 10/718,388	<b>Applicant(s)</b> MILLS, TRUETT P.	
	<b>Examiner</b> Sebastiano Passaniti	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,10,11,14,15 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10,11,14,15,18 and 20 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,19 and 21-26 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office action is responsive to communication received 03/03/2005 –  
Amendment.

Claim 16 has been canceled, as directed.

Claims 1, 2, 4-7, 10, 11, 14, 15 and 17-26 remain pending.

Following is an action on the MERITS:

The indicated allowability of the subject matter in claim 16 has been withdrawn in view of the new pending discussion involving the language “gap beneath said heel”. Any inconvenience to the applicant for not addressing this issue at an earlier time in prosecution is sincerely regretted.

As a substantial portion of the rejections set forth below remain unchanged from a previous action, the newly inserted material found in each rejection (if applicable) has been italicized for the convenience of the applicant.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 5 and 6 STAND *and claims 21, 22, 25 and 26 are* rejected under 35 U.S.C. 103(a) as being unpatentable over Fenton in view of Johnson. As to claims 1 *and 21*, Fenton shows an iron-type club head having a front face (120) and an aperture (Figure 4), the aperture being substantially perpendicular to the plane of the face. As to claim 4, note element (28) in Figure 2 defining a wedge-shaped member. As to claim 5,

Art Unit: 3711

the club head in Fenton includes a face, sole, toe and heel, with the heel including an aperture extending into the front face portion. The language, "adapted for receiving a hosel portion therein" is merely functional and does not further limit the structure of the golf club. As to claim 6, the aperture extends from a front surface of the heel portion. Fenton, however, lacks a heel face, which defines a plane intersecting a plane defined by the front face. To have modified the device in Fenton to provide a heel face plane that intersects the front face plane of the head in order to change the loft of the head would have simply involved an obvious design choice on the part of the skilled artisan in view of the patent to Johnson, since it has been shown to be old in the art to adjust only the heel section relative to the face plane for providing a specific relationship between the striking plate and the hosel. See Figures 1 and 4 and the description in col. 2, line 57 through col. 3, line 55 in Johnson. *As to claims 22 and 25, see Figure 2 in Fenton.* As to claim 26, see Figure 9 in Fenton. *Regarding the phrase, "said club head portion further defining a gap beneath said heel", it is clear that if the club head in Fenton is held at address at an angle, that is, the club is held so that the sole portion at the heel end is raised from the ground plane, a "gap" will exist beneath the heel. The claims do not define any positive structure that relates the gap as being a part of the actual physical body of the club head.*

Claims 1, 2, 5 and 6 STAND rejected under 35 U.S.C. 103(a) as being unpatentable over Koide in view of Johnson. Specific to claims 1 and 2, Figures 8 and 9 in Koide show an aperture (not numbered) for receiving a shaft (21) and hosel (12). As to claims 5 and 6, reference is made to Figure 5 and a showing from Koide of a shaft

Art Unit: 3711

(21), hosel (12) and an angle between the bore in the face and the hosel that is not perpendicular to the plane of the face. See Figures 8 and 9, wherein the aperture in the front striking face is clearly shown. Koide, however, lacks a heel face, which defines a plane intersecting a plane defined by the front face. To have modified the device in Koide to provide a heel face plane that intersects the front face plane of the head in order to change the loft of the head would have simply involved an obvious design choice on the part of the skilled artisan in view of the patent to Johnson, since it has been shown to be old in the art to adjust only the heel section relative to the face plane for providing a specific relationship between the striking plate and the hosel. See Figures 1 and 4 and the description in col. 2, line 57 through col. 3, line 55 in Johnson. *Regarding the phrase, "said club head portion further defining a gap beneath said heel", it is clear that if the club head in Fenton is held at address at an angle, that is, the club is held so that the sole portion at the heel end is raised from the ground plane, a "gap" will exist beneath the heel. The claims do not define any positive structure that relates the gap as being a part of the actual physical body of the club head.*

Claims 5-7 STAND and claims 19, 21, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neher in view of Johnson. Reference is made to Figure 1 in Neher, wherein an aperture is shown as extending through the front face and the rear face of the heel. The aperture (19) may receive stem (31) that is attached to hosel (5). Neher, however, lacks a heel face, which defines a plane intersecting a plane defined by the front face. To have modified the device in Neher to provide a heel face plane that intersects the front face plane of the head in order to

Art Unit: 3711

change the loft of the head would have simply involved an obvious design choice on the part of the skilled artisan in view of the patent to Johnson, since it has been shown to be old in the art to adjust only the heel section relative to the face plane for providing a specific relationship between the striking plate and the hosel. See Figures 1 and 4 and the description in col. 2, line 57 through col. 3, line 55 in Johnson. *Specific to claims 19, 23 and 24, see Figures 1 and 3 in Neher. Regarding the phrase, "said club head portion further defining a gap beneath said heel", it is clear that if the club head in Fenton is held at address at an angle, that is, the club is held so that the sole portion at the heel end is raised from the ground plane, a "gap" will exist beneath the heel. The claims do not define any positive structure that relates the gap as being a part of the actual physical body of the club head.*

Applicant is again respectfully reminded to maintain a clear line of demarcation among each of the instant claims and the claims of U.S. Patent Nos. 6,648,771 and 6,319,146.

Claim 10 is objected to because of the following minor informality: In line 3, --a-- should precede "rear". Appropriate correction is required.

Claims 10, 11, 14, 15, 18 and 20 appear to be allowable over the prior art references of record for the reasons set forth on page 6, lines 10-21 of the remarks received 03/03/2005.

Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Art Unit: 3711

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the hosel connection in Figure 2 in Drake. Note the "gap" at the heel section in Yeh. See Figures 2 and 3 in Bennett.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
June 11, 2005